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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,253	07/28/2000	John R. Mason	1322/40/2	2388

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SUITE 1400  
DURHAM, NC 27707

EXAMINER

NGUYEN, TOAN D

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 04/28/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

S.T.

**Office Action Summary**

Application No.

09/627,253

Applicant(s)

MASON ET AL.

Examiner

Toan D Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>14</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Allowable Subject Matter***

1. The indicated allowability of claims 42 and 51 are withdrawn in view of the newly discovered reference(s) to Ramamurthy (U.S. Patent 6,304,565 B1) and Krishnaswamy et al. (U.S. Patent 5,999,525). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 6-8, 11-18, 22-26, 29, 35, 48-49, 51-59 and 61-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Ramamurthy (U.S. Patent 6,304,565 B1).

For claims 1, 6-8, 16-17, 22, 24-26, 29, 42, 48-49 and 61-64, Ramamurthy discloses method of completing long distance POTS calls with IP telephony endpoints, comprising:

- (a) receiving a signaling system seven (SS7) message in response to a telephony-related action performed by an end user (figure 2, col. 4 lines 51-52);
- (b) determining, based on the SS7 message, whether presence registration processing is required for the end user (col. 4 lines 52-57);
- (c) in response to determining that presence registration processing is required for the end user, automatically generating a presence registration message including presence information indicating to other users a communication medium for contacting the end user using

Art Unit: 2665

a messaging protocol and indicating that the end user is currently available to receive message protocol messages via the communications medium (figure 3, col. 5 lines 59-61); and

(d) transmitting the presence registration message to the presence server over an IP network (figure 1, col. 3 lines 41-43).

For claims 11-15, 35 and 51-59, Ramamurthy discloses method of completing long distance POTS calls with IP telephony endpoints, comprising:

(a) receiving, at presence registration and routing node, an IP message for determining presence information for a first end user, the presence information indicating a communication medium for contacting the first end user using a messaging protocol and the fact that the first end user is currently available to receive messaging protocol messages via the communications medium (figures 2-5, col. 5 lines 59-61 and col. 5 lines 64-67);

(b) formulating a query to a presence database for obtaining the presence information (col. 4 lines 23-45);

(c) obtaining the presence information from the presence database (col. 4 lines 23-45); and

(d) forwarding the presence information to a second end user, wherein the second end user uses the presence information to determine the appropriate communication medium for contacting the first end user using the messaging protocol and the availability of the first end user to receive messaging protocol communications via the communications medium (figure 2, col. 6 lines 10-22).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2-4, 9-10, 18-21, 23, 27-28, 30-34, 36-41, 43-45, 47, 50 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramamurthy (U.S. Patent 6,304,565 B1) in view of Krishnaswamy et al. (U.S. Patent 5,999,525).

For claims 2 and 43, Ramamurthy discloses a PSTN telephone and the signaling system seven message is an IAM message (figure 1, col. 3 lines 5-6).

However, Ramamurthy does not disclose an IAM message. In an analogous art, Krishnaswamy et al. disclose an IAM message (figure 1F, col. 93 line 21). One skilled in the art would have recognized an IAM message to use the teachings of Krishnaswamy et al. in the system of Ramamurthy. Therefore, it would have been obvious to one of ordinary skill in the art at the time invention, to use the IAM message as taught by Krishnaswamy et al. in

Art Unit: 2665

Ramamurthy's system with the motivation being to provide a called party number and optional calling party number (col. 93 lines 21-22).

For claims 3 and 44, Krishnaswamy et al. disclose the telephony-related action includes entering DTMF digits using a PSTN telephone handset after a call has been established, the DTMF digits forming a code for instructing an end office to formulate the SS7 message (col. 28 lines 11-13).

For claims 4, 28 and 45, Krishnaswamy et al. disclose the SS7 message is a transaction capabilities application part (TCAP) message containing presence information for the end user (col. 301 line 9).

For claims 18-19, 30-33 and 36-40, Ramamurthy discloses wherein obtaining the presence information from the presence database includes obtaining the presence information from a presence database located internal to the presence registration and routing node (col. 3 lines 41-45 and col. 4 lines 23-45).

For claims 9-10, 20-21, 34, 41, 50 and 60, Krishnaswamy et al. disclose sending a second message to an accounting and billing system (section VIII Part C. Accounting or col. 23 lines 15-18 and Section XXI. Billing or col. 20 lines 40-44).

For claims 23 and 47, Krishnaswamy et al. disclose an advanced database communication module for encapsulating the presence registration message in an IP packet and transmitting the IP packet to a presence server over an IP network (col. 17 lines 15-18).

For claim 27, Krishnaswamy et al. disclose the SS7 message is an ISDN user part (ISUP) message (col. 18 lines 5-9).

Art Unit: 2665

7. Claims 5 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramamurthy (U.S. Patent 6,304,565 B1) in view of McConnel et al. (U.S. Patent 6,373,930 B1).

For claims 5 and 46, Ramamurthy does not disclose a home location register (HLR) and a visitor location register (VLR). In an analogous art, Miller et al. disclose a home location register (HLR) and a visitor location register (VLR) (figure 4, col. 11 lines 52-63). One skilled in the art would have recognized a home location register (HLR) and a visitor location register (VLR) to use the teachings of Miller et al. in the system of Ramamurthy. Therefore, it would have been obvious to one of ordinary skill in the art at the time invention, to use the home location register (HLR) and the visitor location register (VLR) as taught by Miller et al. in Ramamurthy's system with the motivation being to serve standard functions in the wireless network such as managing service profiles and authentication information for subscribers and mobile stations (col. 11 lines 54-56).

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-64 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan D Nguyen whose telephone number is 703-305-0140. The examiner can normally be reached on Monday- Friday (7:00AM-4:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Huy Vu can be reached on 703-308-6602. The fax phone numbers for the

Application/Control Number: 09/627,253

Page 7

Art Unit: 2665

organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

TN  
T.N.



**ALPUS H. HSU  
PRIMARY EXAMINER**